

Application Serial No. 09/884,022

Attorney Docket No. 52493.000179

REMARKS

The December 6, 2004 Office Action has been received and its contents carefully considered. Claims 1-26 are pending in the present application. By this Amendment, claims 1, 9, 14-19 and 22-26 are amended. For the reasons set forth below, the claims are believed to be in condition for allowance.

No new matter has been added by this amendment. Support for the amendments to the claims may be found on page 6, line 24 - page 7, line 15; page 9, lines 25-30; page 10, lines 19-25; and Figs. 1, 2 and 4, for example.

A. CLARIFICATION OF THE REJECTION

Applicant respectfully requests clarification of the rejection. In paragraph 20, the Office Action asserts that claims 14-19, 20-21, 22-26, list all the same elements of claims 1-6, 7-8, 9-13 but in system form rather than method form. The Office Action further asserts that therefore, the supporting rationale of the rejection to claims 1-6, 7-8, 9-13 applies equally as well to claims 14-19, 20-21, 22-26.

However, Applicant respectfully submits that such assertions in the Office Action fail to set forth the basis of rejection of claims 14-19, 20-21, and 22-26. That is, it is unclear as to whether such claims are rejected under the teachings of Valentine and Bruce (under which teachings claim 1 is rejected), or under the teachings of Valentine, Bruce and Smolen (under which teachings claim 6 is rejected), or under the teachings of Valentine, Bruce and Redmond (under which teachings claim 11 is rejected).

Accordingly, the basis of the rejection of claims 14-19, 20-21, and 22-26 is fully unclear. The Examiner is requested to clarify the manner in which the applied art is being applied against

Application Serial No. 09/884,022

Attorney Docket No. 52493.000179

the pending claims and/or withdraw the rejection.

B. THE 35 U.S.C. §101 REJECTION

In the Office Action, claims 1-4, 6 and 9, 12-13, 14-17, 19, 22, 25-26 are rejected under 35 U.S.C. 101. The Office Action asserts that the claimed invention is directed to non-statutory subject matter, or otherwise lacks patentable utility.

The Office Action asserts that claims 1-4, 6, 9, 12-13, 14-17, 19, 22, 25-26 recite a method, which does not require any form of computer hardware software, to complete the task as recited in the claims; and that in other words, the method and system as claimed can be done by a person pen or pencil and on papers. The Office Action further asserts that the process as claimed is a normal routine decision making, known to human as task management or task assignment; and that thus, claims 1-4, 6 and 9, 12-13, 14-17, 19, 22, 25-26 dictate a process that can be carried on by human being, per se, and constitutes nonstatutory subject matter. These assertions set forth in the Office Action are respectfully traversed.

Applicant respectfully asserts this rejection has no basis under 35 U.S.C. § 101. It is well established that §101 requires that (1) the invention have utility or operativeness and (2) the invention falls within one of the proper subject matter categories (process, machine, article of manufacture, and composition of matter).

The Examiner's rejection does not claim that the present invention has no utility - which it clearly does. Regarding subject matter category, the invention of each of claims 1-4, 6, 9, 12 and 13 is recited as a "method," which plainly falls within the ambit of the "process" category set forth in §101. Further, claims 14-17, 19, 22 and 25-26 are directed to a system, which clearly falls under patentable subject matter.

Application Serial No. 09/884,022

Attorney Docket No. 52493.000179

MPEP §706.03(a), which governs rejections under § 101, provides no support for the rejection set forth in the Office Action. MPEP §706.03(a) provides that rejections under §101 may be made for the following reasons: nonstatutory subject matter (printed matter, naturally occurring article, scientific principle), lack of utility, and inoperativeness. None of these apply here. Applicant is unaware of any requirement imposed by the Patent Statute or controlling precedent requiring an Applicant to recite structure in a method claim.

However, in response to the Examiner's comments and in order to expedite prosecution of this application, Applicant has made various amendments to the claims to add technology to the claims. As noted above, ample support for the amendments may be found, for example, on page 6, line 24 - page 7, line 15; page 9, lines 25-30; page 10, lines 19-25; and Figs. 1, 2 and 4, for example.

Applicant submits that such amendments to the claims moots the issue regarding §101. Applicant submits that the claims clearly now recite technology and requests that the §101 rejection be withdrawn.

C. THE PRIOR ART REJECTIONS

1. The Rejection Based on Valentine and Bruce

The Office Action rejects claims 1-5, 7-10, and 13 under 35 U.S.C. 103(a) as being unpatentable over Valentine (US 5,898,770) and Bruce (Bankrate.com). The Examiner is respectfully requested to reconsider the asserted rejection based on the remarks set forth below.

Claim 1 recites in particular, establishing a contact with a consumer; offering a privacy service wherein the privacy service comprises reducing unsolicited communications for a combination of communication channels to the consumer; enrolling the consumer to receive the

Application Serial No. 09/884,022

Attorney Docket No. 52493.000179

privacy service via a single consumer contact; and processing consumer information, using the processing system, for a consumer selected combination of communication channels. Applicant respectfully submits that the applied art fails to teach or suggest the features of claim 1.

As described in the Abstract, Valentine is directed to an apparatus and method within a communication switch for prompting a telemarketing organization to remove a consumer phone number from a call list and that includes a call list deregistration system which establishes a phone connection with a telemarketing organization phone and plays a specified message on the successful connection. Valentine describes that entry of a specified code on a telephone keypad activates the system to establish a connection with the telemarketing organization and play a specified message thereto. Valentine further teaches in column 2, lines 35-63, that the Valentine invention provides, in a communications switch, a call list deregistration system and method for prompting a telemarketing organization to remove a phone subscriber's name or phone number from a call list. To actuate the call list deregistration system, a consumer enters a specified code after receipt of a telemarketing call. The call list deregistration system responds thereto by generating a call back to that telemarketer's phone, as identified by its caller ID, and then playing a specified message which informs the telemarketing organization to remove the consumer from the telemarketer's call list.

The Office Action notes that Valentine fails to teach an offering a privacy service which reduces unsolicited communications via multiple communication channels to customer, allowing the customer enrolls the privacy service via a contact, and then processing the customer information. The Office Action attempts to cure the deficiencies of Valentine with the teachings of Bruce.

Application Serial No. 09/884,022

Attorney Docket No. 52493.000179

That is, the Office Action asserts that Bruce teaches *offering* a privacy service wherein the privacy service comprises reducing unsolicited communications for a combination of communication channels to the consumer (Bruce discloses the offering a few organizations which provide the opting out from unsolicited mail, telephone or email to the customer) (page 1, line 35-42, and page 2, line 24-34, and page 3, line 29-33), *enrolling* the consumer to receive the privacy service via a single consumer contact (Bruce discloses the customer registers the DMA's preference services for unwanted advertising mail, telephone or email by printing it and mail it to them) (page 2, line 25-26 and line 30-31); and *processing* consumer information for a consumer selected combination of communication channels (Bruce discloses the customer information will be put into one or many of the DMA's Mail, Telephone or E-mail Preference Service "delete file") (page 2, line 24-26 and line 29-31).

These assertions as set forth in the Office Action are respectfully traversed. Claim 1 clearly sets forth various features associated with the "single consumer contact" and the "consumer selected combination of communication channels", as well as the interrelationship there between. Bruce fails to provide teachings so as to cure the deficiencies of Valentine.

To explain, Applicant of course acknowledges that Bruce teaches various aspects of stopping unwanted calls, mail and e-mail. However, Bruce fails to teach the "single consumer contact" and the "consumer selected combination of communication channels", as well as the interrelationship there between, as recited in claim 1. In particular, Applicant has reviewed the Office Action comments on page 3 (second to last line) to page 4, line 11. Illustratively, the Office Action asserts that "Bruce discloses the offering a few organizations which provide the opting out from unsolicited mail, telephone or email to the customer" (top of page 4 of the Office

Action). Of note, is the description of "unsolicited mail, telephone *OR* email." That is, Bruce does not appear to teach collectively opting out of each of such three mediums, much less the particular processing as set forth in claim 1.

Further, the Office Action asserts that Bruce teaches "processing consumer information for a consumer selected combination of communication channels (Bruce discloses the customer information will be put into one or many of the DMA's Mail, Telephone or E-mail Preference Service "delete file") (page 2, line 24-26 and line 29-31). Applicant traverses such assertions.

That is, the Office Action refers to page 2, lines 24-26 and 29-34. As an initial matter, such reference to Bruce is not understood, in that page 2 of Bruce appears to have only 25 lines, i.e., based on the copy of Bruce provided in the Office Action. Further, it is respectfully submitted that page 2 of Bruce fails to teach the features associated with the "single consumer contact" and the "consumer selected combination of communication channels", as well as the interrelationship there between, as recited in claim 1. Applicant notes that Bruce describes opting out of telephone sales calls and opting out of mail solicitation. However, Bruce fails to teach such opting out in a collective manner, i.e., between the different channels, much less the specifics of claim 1.

To explain further, on page 2 of Bruce, Bruce describes the DMA's Mail Preference Service lets you opt out of receiving "junk mail" or, as the DMA calls it, "unsolicited national advertising mail." You'll have to print it and mail it to the address listed, because the DMA needs your signature to put you in its "delete file," which is forwarded to DMA members. Bruce further notes that the same goes for the DMA's Telephone Preference Service. It lets you opt out of getting unsolicited telephone sales calls from its members. Again, you'll have to print the

page, sign it and mail it. Further, Bruce reflects that opting out with the DMA's members won't stop all telephone and direct mail solicitation, but it will reduce it significantly.

Applicant submits that such disclosure of Bruce cannot fairly be interpreted to teach or suggest the invention as recited in claim 1, either alone or in combination with Valentine. That is, Bruce fails to teach opt out of the various mediums in a collective manner, "via a single consumer contact" so as to teach claim 1.

The Office Action (bottom of page 3 - page 4, line 3) also refers to Bruce on page 1, lines 35-42. Applicant respectfully submits that such reference appears to be in error in that page 1 of Bruce only sets forth 21 lines. Further, upon general review of page 1 of Bruce, Bruce fails to set forth the teachings as alleged in the Office Action. Bruce does teach that the concept of opting out is simple -- you contact various organizations and companies and let them know you want to be taken off their mailing lists. Bruce comments that it's no walk in the park -- it takes work on your part -- but if privacy is your goal, you'll probably find the time spent is worthwhile. However, this disclosure of Bruce merely refers to opting out of mailing lists. Such disclosure of Bruce falls far short of teaching the claimed features associated with the "single consumer contact" and the "consumer selected combination of communication channels", as well as the interrelationship there between, so as to cure the deficiencies of Valentine.

Further, the Office Action refers to page 3 of Bruce. Applicant submits that page 3 of Bruce also fails to teach or suggest features so as to teach the "combination of communication channels" related features of claim 1, so as to be combined with Valentine and cure the deficiencies of Valentine.

For at least the above reasons, it is respectfully submitted that claim 1 defines patentable

subject matter. Further, independent claims 7 and 9, as well as claims 14, 20 and 22 define patentable subject matter at least for reasons similar to those set forth above with respect to claim

1. Further, the various dependent claims are allowable at least based on their dependencies on the independent claims, as well as for the additional features set forth therein.

2. The Rejection Based on Valentine, Bruce and Smolen

In paragraph 15, the Office Action rejects claims 6, 12 under 35 U.S.C. 103(a) as being unpatentable over Valentine and Bruce as applied to claims 1 and 9 and further in view of Smolen (US 5,915,243).

The Office Action appears to assert that Valentine and Bruce fail to disclose the providing at least one incentives to customer. The Office Action further asserts that Smolen teaches providing one or more consumer incentives (Smote teaches delivering promotions to the customer on the basis of an information profile of customer), and that it would have been obvious to combine such teaching with the Valentine and Bruce combination.

Applicant submits that Smolen fails to cure the deficiencies of Valentine and Bruce discussed above. That is, even if it were obvious to somehow modify the applied art to Valentine and Bruce based on the teachings of Smolen, such would still fail to teach or suggest the claimed invention. The applied art would still fail to teach or suggest the particular processing of claims 1 and 9 relating to the multiple communication channels.

Accordingly, it is respectfully submitted that claims 6 and 12 are allowable at least based on their dependencies on the independent claims, as well as for the additional features set forth therein. Withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

3. The Rejection Based on Valentine, Bruce and Redmond

Application Serial No. 09/884,022

Attorney Docket No. 52493.000179

In paragraph 18, the Office Action rejects claim 11 under 35 U.S.C. 103(a) as being unpatentable over Valentine and Bruce as applied to claim 9 and further in view of Redmond (US 6,370,139).

The Office Action asserts that regarding claim 11, Valentine-Bruce is relied upon for the disclosure set forth in the claim 1 rejection. The Office Action asserts that Redmond teaches the method of claim 9 wherein consumer information comprises a combination of email address data, telephone number data and mailing address data (Col. 1, L. 43-51); and that thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated a customer profile includes his/her mailing address, telephone number and email address, as suggested of Redmond, into the proposed combination of applied art to Valentine and Bruce.

However, Applicant submits that Redmond fails to cure the deficiencies of Valentine and Bruce discussed above. That is, even if it were obvious to somehow modify the applied art to Valentine and Bruce based on the teachings of Redmond (relating to consumer information), such would still fail to teach or suggest the claimed invention. That is, the applied art would still fail to teach or suggest the particular processing of claim 9 relating to the multiple communication channels.

Accordingly, it is respectfully submitted that claim 11 is allowable at least based on its dependency on the independent claim 9, as well as for the additional features set forth therein. Withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

Application Serial No. 09/884,022

Attorney Docket No. 52493.000179

4. The Rejection of Claims 14-19, 20-21, and 22-26

Applicant respectfully submits that the rejection of claims 14-19, 20-21, 22-26 is unclear for the reasons set forth above. In particular, it is unclear which applied art is being applied against such claims.

However, for the reasons set forth above, it is submitted that the applied art fails to teach or suggest the claimed invention. Withdrawal of the 35 U.S.C. §103 is respectfully requested.

D. CONCLUSION

Applicant respectfully submits that the application, as amended, is in condition for allowance. If the Examiner believes that prosecution might be advanced by discussing the application with Applicants' counsel, in person or over the telephone, we would welcome the opportunity to do so.

In the event any fees are due, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS

By: 

James R. Miner
Registration No. 40,444

Hunton & Williams LLP
1751 Pinnacle Drive
Suite 1700
McLean, VA 22102
Telephone (703) 714-7400
Facsimile (703) 714-7410

Dated: March 7, 2005